

### **REMARKS/ARGUMENTS**

Applicants respond herein to the Office Action dated February 8, 2011.

Claims 1-4, 6-8 and 10-12 are pending in the application. Claims 5 and 9 have been canceled.

The Examiner considered the response entered with the RCE of February 12, 2010 as not being fully responsive because of omissions or enumerated matters. Specifically, the Examiner noted that the newly submitted claim 1 (with amendments) was directed to an invention independent or distinct from the invention as originally claimed. The Examiner considered that the original claims presented were directed towards a surgical probe having the electrodes (proximal and distal) and the insulator all having the same diameter (approximately the same) whereas the “present” claims are now drawn towards a different embodiment wherein the outside diameters are different. Since Applicants received an action on the merits for the originally presented invention, the Examiner considered this invention to have been constructively elected for prosecution on the merits. The Examiner accordingly withdrew claims 1, 2-4 and 6-11 from consideration, but permitted Applicants to supply the omission or correction, in order to avoid abandonment.

In response thereto, it is submitted that original amendment to the claims did not, in fact, contradict the original claimed invention of the electrodes and insulator all having the same diameter. Instead, an internal element of the hollow body 42, shown in Figure 3, was claimed as having the varying outer diameters with the distal diameter of the hollow body forming distal electrode 16 and the smaller proximal diameter 34 of the hollow body. Smaller diameter area 34 is enclosed with insulator 38 and metal tube 40 which constitute the insulator and proximal electrode respectively. Layer 36, in conjunction with tube 40 and insulator 38, provides the originally claimed same diameter of the proximal electrode and insulator relative to the distal electrode (see Figures 3 and 4 in this regard). To ensure such structural sameness of diameter, claim 1 (and claims dependent thereon) have been amended to specifically require that the structure of hollow body with the portion of smaller outside diameter supports the proximal electrode and the insulator thereon “wherein the outside diameter of the two electrodes and the outside diameter of the insulator are approximately equal” as originally constructively elected and examined. The structure of the hollow body has been claimed, with the amendment as previously submitted, as a further limitation which clearly differentiates the presently claimed

invention from that of the cited prior art for reasons as previously submitted. These reasons are reiterated as follows with clarifying insertions and emphasis:

Claims 1-4, 6-8 and 10 were rejected under 35 USC 103(a) as being unpatentable over Maguire et al. (US 5,913,854) in view of Desinger (US 6,723,094). Claim 9 was rejected under 35 USC 103(a) as being unpatentable over Maguire et al. (US 5,913,854) in view of Desinger (US 6,723,094) and further in view of Pantages et al. (US 6,259,760) and claims 11-12 were rejected under 35 USC 103(a) as being unpatentable over Maguire et al. (US 5,913,854) in view of Desinger (US 6,723,094) and in further view of Crites et al. (3,568,660).

Independent claim 1 (and the claims dependent thereon) contains the limitations of a probe, "...configured with a mechanical strength, rigidity and perforation capability that permits insertion of the shaft into body tissue..." In addition, claim 1 specifies that the probe contains a hollow body that extends from the handle and integrally forms the distal electrode. This integral configuration provides the mechanical strength and rigidity to provide the body tissue with insertion capability and also prevents breakage, upon removal of the probe, without risk of residual material remaining in ablated tissue.

Furthermore, the hollow body which is used as a conduit for cooling fluid provides a support for the proximal electrode and the insulator body which insulates the proximal electrode from the conductive hollow body and the distal electrode. In order to provide such configuration **the hollow body is claimed, as being comprised of portions of smaller and larger outside diameter**. The larger diameter portion of the **hollow body**, comprising the distal electrode and the smaller diameter portion of the **hollow body** comprising the support for the insulator or insulating layer and the proximal electrode, **all with the resultant same outer diameter**. Accordingly, the proximal and distal electrodes comprise the outer surface of the shaft and are claimed as being axially separated from each other by the insulator, as well. A utilization described in the application of the claimed device is for tumor ablation with direct perforation of the tumor by the distal electrode for the heated ablation removal of the tumor.

It is submitted that Maguire et al. is an inappropriate reference with respect to the claimed invention. Maguire discloses a flexible ablation catheter for controlled ablation of only surface tissue, such as cardiac tissue with linear ablation electrodes (electrodes arranged along the length of the catheter and specifically not the tip). This electrode positioning and use is particularly for surface ablating of cardiac tissue (see col. 1, lines 17-47 and col. 3, lines 43-54). It is in no way

configured for insertion into tissue (all the ablating electrodes 18 are configured as bands around tip portion 10) and the catheter has no “mechanical strength, rigidity (it is described as being flexible) or perforation capability” (note the blunt end of 20) as claimed herein.

Furthermore, because of the described use with cardiac tissue, Maguire’s catheter would not be modified to have a perforation capability as in the Desinger reference. Maguire also teaches that coagulation effects (col. 1, lines 25-28) are to be avoided with the ablation, which would occur with insertion into tissue as with the claimed device. In direct contrast, Desinger specifically operates to provide the coagulation effect (see abstract). The teachings of Desinger would not be used by one skilled in the art to modify the Maguire device, given the clear teaching in this reference of the ill effects which would occur if the modification suggested in the Office Action were to be adopted.

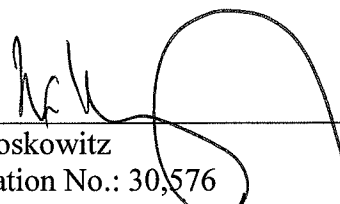
None of the references, including Desinger (who is an inventor in the present application), discloses, teaches or even suggests using the claimed **integral hollow body**, which provides strength to the distal electrode for enhanced tissue insertion (and removal) capability, **nor the variable diameter portions of the hollow body**, which permit the structural configuration of the respective electrodes and support provided by the hollow body to the insulator and proximal electrode.

Accordingly, the Examiner is respectfully requested to reconsider the application, and rescind the proposed withdrawal of claims from examination. The Examiner is further respectfully requested to fully consider the prior filed response, reproduced above, and allow the claims as amended and pass this case to issue.

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SUBMITTED ELECTRONICALLY  
THROUGH THE PATENT AND  
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Respectfully submitted,



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